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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,161	08/22/2003	Michael D. Sawyer	P1965US00	9021
24333	7590	06/27/2005		
GATEWAY, INC. ATTN: SCOTT CHARLES RICHARDSON 610 GATEWAY DRIVE MAIL DROP Y-04 N. SIOUX CITY, SD 57049				EXAMINER PHAM, HAI CHI
				ART UNIT 2861 PAPER NUMBER
DATE MAILED: 06/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/646,161	SAWYER, MICHAEL D.
	Examiner Hai C. Pham	Art Unit 2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 June 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8, 19-26 and 30-37 is/are rejected.
- 7) Claim(s) 9-11, 27-29 and 38-40 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/22/03, 05/03/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 12-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/14/05.

### *Drawings*

2. Figure **1A** should be designated by a legend such as --PRIOR ART-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 5, 7-8, 19, 23, 25-26, 30, 34 and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by McFarland et al. (EP 1332884).

McFarland et al., an acknowledged prior art, discloses a system for labeling a storage medium provided within a drive bay (130) of a computer system (120), the system comprising a chassis drive unit (drive bay 130), a transport mechanism capable of accepting the unit of optical media and positioning the unit within the drive in an operational position (the drive bay typically and inherently includes an opening or a pivotable door and a tray for accepting the storage medium through the door to a recording position within the drive bay), a first head (laser printing unit 136) coupled to the chassis drive unit, the first head capable of optically communicating with the unit of optical media on a first side thereof (the laser printing unit 136 being an integral part of the drive bay for recording data onto the bottom side 138 of the storage medium 131), and a second label printing head (laser labeling unit 135) coupled to the chassis drive unit, the second label printing head capable of applying a visual label associated with the unit of optical media on a second side thereof (the laser labeling unit 135 being an

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integral part of the drive bay for writing a label on the upper side 139 of the storage medium 131), wherein the first head and the second label printing head are capable of the optically communicating and the applying of the visual label while the unit of optical media is positioned within the drive in the operational position (see paragraphs [0009]-[0011]).

McFarland et al. further teaches the second label printing head (135) including:

- a movable print head (paragraph [0012]),
- an ink jet print head (ink jet head) (paragraph [0007]),
- a laser print head.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 6, 20-21, 24, 31-32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland et al. in view of Bronson (Pub. No. U.S. 2003/0133005).

McFarland et al. discloses all the basic limitations of the claimed invention except for the first head including an optical read-only head or an optical read-write head, and the second label printing head includes a thermal print head.

Bronson discloses a labeling apparatus for labeling a disk storage medium, the apparatus including a movable label printer device (214) for forming a label on the upper side of the storage medium (115) and a laser head (118) including separate read laser (108) operating at a lower power level for reading data from the lower side of the storage medium and writing laser (109) operating at a higher power level for writing data onto the lower side of the storage medium. Bronson further teaches the label printer device being a thermal writing head (paragraph [0031]).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate a read-only or a read-write head in the laser head of McFarland et al. as taught by Bronson. The motivation for doing so would have been enhance the life span of the read/write laser heads. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate a thermal writing head as a label printing head in the device of McFarland et al. as taught by Bronson since Bronson teaches this to be known in the art to use any suitable printing type device as a label print head, which is also suggested by McFarland in paragraph [0007]).

7. Claims 4, 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland et al. in view of Kahle (U.S. 6,074,031).

McFarland et al. discloses all the basic limitations of the claimed invention except for the second label printing head includes a fixed print head.

Kahle discloses an apparatus for printing labels on digital recording medium, the apparatus includes the label print head (22), which is configured so as to be either moved across the surface of the digital recording medium by translation or fixed with respect to the digital recording medium by the provision of a sufficient number of jets to print the entire printable area of the medium (col. 1, line 59 to col. 2, line 5).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a fixed label print head in the device of McFarland et al. as taught by Kahle. The motivation for doing so would have been to accurately print the label within the printing area of the recording medium without the inconvenience of controlling the motion of the label print head over the surface of the recording medium.

#### ***Allowable Subject Matter***

8. Claims 9-11, 27-29 and 38-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter: the primary reason for the indication of the allowability of claims 9, 27 and 38 is the inclusion therein, in combination as currently claimed, of the limitation "wherein the unit of optical media is equipped with an electronic labeling device" and that "the second is capable of communicating with the electronic labeling device when the unit is

accepted within the transport mechanism in the operational position", which are not found taught by the prior art of record considered alone or in combination.

Claims 10-11, 28-29 and 39-40 are allowable because they are dependent from claims 9, 27 and 38 above.

***Pertinent Prior Art***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anderson et al. (U.S. 6,778,205) discloses an apparatus for forming visible labels on optical disc using a writable optical disc drive, which includes a label writing head and a read-only head positioned on opposite sides of the optical disc.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM  
PRIMARY EXAMINER

June 23, 2005